UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,029	09/11/2003	Wen-Hua Lin	LA-7196-128	5809

167	7590	11/01/2006

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EXAMINER
DENG, ANNA CHEN

ART UNIT	PAPER NUMBER
2191	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 September 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-6_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-6_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _11 September 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the application filed on 9/11/2003.

2.   Claims 1 – 6 are pending.

3.   Claims 1 – 6 have been examined.

Specification

4.   The use of the trademark JAVA Virtual Machine, MICROSOFT Virtual Machine, has been noted

in this application. It should be capitalized wherever it appears and be accompanied by the generic

terminology.

　　　Although the use of trademarks is permissible in patent applications, the proprietary nature of the

marks should be respected and every effort made to prevent their use in any manner which might

adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claims 2 – 3, and 5 – 6 are rejected under 35 U.S.C. 112 second paragraph because claims 2

and 5 contain the trademark/trade name Java Virtual Machine, and claims 3 and 6 contain the

trademark/trade name Microsoft Virtual Machine. Where a trademark or trade name is used in a claim as

a limitation to identify or describe a particular material or product, the claim does not comply with the

requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App.

1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to

identify any particular material or product. A trademark or trade name is used to identify a source of

goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the

goods associated with the trademark or trade name. In the present case, the trademark/trade name is

used to identify/describe virtual machine and, accordingly, the identification/description is indefinite. Both

'Java Virtual Machine' and 'Microsoft Virtual Machine' will be interpreted to virtual machine thereafter.

7.   Claim 1 recites the limitation "those essential objects", "the compression module" in claim 1, lines

10, and 16, claim 4, lines 8, and 14-15, respectively. There are insufficient antecedent basis for those

limitations in the claims. Claims 1-6 are rejected under 35 U.S.C. 112 second paragraph because they

lack antecedent basis.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 1 – 6 are rejected under 35 U.S.C. 102 (e) as being anticipated by Fresko et al. US

2003/0009743 A1 (hereinafter Fresko).

Per Claim 1:

Fresko discloses:

-          An embedded system program code reduction method for scaling down a virtual machine

           and a set of application programs running on the virtual machine that are to be burned into

           an embedded system, wherein the virtual machine includes an object library, a complier, and

           a runtime environment (FIG. 1, paragraph 0020);

-          the embedded system program code reduction method (paragraphs 0028) comprising:

- a compilation procedure for compiling the source code of each application program into bytecode (FIG. 1, Java Compiler 106, ".class" class Files (byte codes) 107, paragraph 0020, lines 10 – 15);

- an object picking procedure for picking those essential objects that are required for use by the application programs during runtime and collectively pack all picked objects into an essential-objects package (FIG. 4, paragraphs 0062 – 0063) ;

- a compression procedure for compressing the essential-objects package into a compressed file of essential objects (FIG. 4, step 407, paragraph 0065); and

- a code integration procedure for integrating each bytecode-based application program, the compressed file of essential objects from the compression module (FIGS. 4, step 408, paragraph 0065, FIG. 5, paragraph 0068), and

- the runtime environment from the virtual machine into a set of embedded system program code which is to be burned into the embedded system (FIG. 6, paragraphs 0077 – 0078).

Per Claim 2:

Fresko discloses:

- The embedded system program code reduction method of claim 1, wherein the virtual machine is a Java Virtual Machine (FIG. 1, paragraph 0018).

Per Claim 3:

Fresko discloses:

-       The embedded system program code reduction method of claim 1, wherein the virtual

machine is a Microsoft Virtual Machine (FIG. 1, paragraph 0018).

Per Claims 4 – 6:

These are the system version of the claimed method discussed above (claims 1 – 3), wherein all

claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus,

accordingly, these claims are also anticipated by Fresko.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Anna Deng whose telephone number is 571-272-5989. The examiner can normally be

reached on Monday to Friday 9:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

Zhen can be reached at 571 –272-3708. The fax phone number for the organization where this

application or proceeding is assigned is 703-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC)

at 866-217-9197 (toll-free).

Anna Deng

September 18, 2006